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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,335	10/03/2003	Lawrence Edwin Wilkerson	EMPATHY	2559
7590 11/24/2004			EXAMINER	
Risto A. Rinne, Jr. Suite E 2173 East Francisco Blvd. San Rafael, CA 94901			HARRIS, CHANDA L	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/678,335

Applicant(s)

WILKERSON ET AL.

Examiner

Chanda L. Harris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Note: Please disregard the previous office action in lieu of the following action.

Claim Rejections - 35 USC § 101

1. Claims 1 and 2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because it is not within one of the four statutory categories of inventions listed in 35 U.S.C. 101. Although it is initially characterized in the preamble as a "product", a plurality of questions in which a first and second participant provide answers to is merely an abstract idea.
2. Claims 3-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The invention is characterized as a system. Usually, a system is directed to apparatus or structure in one form or another. However, there is no structure disclosed corresponding to the "means" recited. Moreover, a claim to "software" is not statutory and neither is its manipulation. The claims are indefinite because "means for" recitations without corresponding structure in the specification are incapable of reasonably precise interpretation. Also, the claims have no practical utility. Establishment of a level of empathy appertaining to an individual is so nebulous as to lack assuredness and predictability implicit in the requirement that a claimed invention be concrete and tangible.
3. Claims 24-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a claim to pass muster, the recited limitations must somehow apply, involve, use, or advance the technological arts.

In the present case, Claims 24-28 only recite an abstract idea. The recited steps of merely providing a plurality of questions, having a first participant provide a first set of answers to said at least some of the plurality of questions, having the first participant provide a second set of answers to said at least some of the plurality of questions attempting to anticipate how a second participant will answer each of said at least some of the plurality of questions; having the second participant provide a third set of answers to said at least some of the plurality of questions; and having the second participant provide a fourth set of answers to said at least some of the plurality of questions attempting to anticipate how the first participant will answer each question does not apply, involve, use, or advance the technological arts since all of the recited limitations can be performed in the mind of the user or by use of a pencil and paper. These limitations only constitute an idea of how to determine empathy.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention merely provides a plurality of questions that are answered by two participants. There is no useful, concrete, and tangible result that occurs as a result of providing a plurality of questions that are answered by two participants. The claims fail to satisfy the requirement for a concrete and tangible result since no structure is being manipulated or converted by the process.

Therefore, claims 24-28 are deemed to be directed to non-statutory subject matter as they are not of the technological arts and do not provide a useful, concrete, and tangible result.

4. Claims 29-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because the claimed invention does not produce a useful, concrete, and tangible result. There is no practical utility resulting from the method steps recited because the claimed invention cannot be said to be concrete and tangible.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Von Fellenberg (US 4,627,818)

-determining empathy

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- Madison (US 3,764,135)

-empathy game

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Harris whose telephone number is 703-308-8358. The examiner can normally be reached on M-F 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Chanda L. Harris
Examiner
Art Unit 3714

ch.